

## STATEMENT OF CONSIDERATIONS

### REQUEST BY CABOT SUPERIOR MICROPOWDERS FOR AN ADVANCE WAIVER OF DOMESTIC AND FOREIGN INVENTION RIGHTS UNDER DOE COOPERATIVE AGREEMENT NO. DE-FC26-04NT42276; W(A)-04-065, CH-1243

The Petitioner, Cabot Superior MicroPowders, a Division of Cabot Corporation (Cabot) was awarded this cooperative agreement for the performance of work entitled, "Development of Advanced LED Phosphors by Spray-Based Processes for Solid State Lighting Applications." The purpose of the cooperative agreement is to develop luminescent materials using aerosol processes for making improved LED devices for solid state lighting applications. Further details of the proposed work are provided in response to question 2 of the waiver petition.

The total estimated cost of the cooperative agreement is \$3,762,008 with the DOE share being \$2,200,000 or 58.5%, while the remaining cost share of 41.5%, or \$1,562,008, will be provided by Cabot. The period of performance is from October 1, 2004 through September 30, 2007.

In its response to question 5 of the attached waiver petition, Cabot has described its technical competence in the field of spray-based powders and spray-based production of luminescent materials. Cabot has provided a detailed description of its expertise, along with a list of issued patents and patent applications, in response to this question. Cabot's response demonstrates its technical competency in the field of spray-based powders for the production of luminescent materials.

In its response to question 10 (amended, per attached e-mail to M. Dvorscak from Jaimes Sher of Cabot dated May 2, 2005, attached) of the attached waiver petition, Cabot states that there are a large number of participants in the development of technology of luminescent materials, and that grant of the waiver would provide for healthy competition with other companies in the market place. Thus grant of the waiver will not place Cabot in a preferred or dominate position in this field, and is likely to have a positive effect on competition and market concentration.

The subject cooperative agreement will be modified to add the Patent Rights--Waiver clause in conformance with 10 CFR 784.12, wherein Cabot has agreed to the provisions of 35 U.S.C §§ 202, 203, and 204. This waiver clause will also include a paragraph entitled U.S. Competitiveness, in which Cabot agrees to substantial U. S. manufacture of subject inventions (attached hereto). Additionally, Cabot agrees not to transfer subject inventions to any other entity unless that other entity agrees to these same requirements.

Considering the foregoing, it is believed that granting the waiver will provide the Petitioner with the necessary incentive to invest resources in the commercialization of the results of the agreement in a fashion which will make the agreement's benefits available to the public in the shortest practicable time. In addition, it would appear that grant of the above requested waiver would not result in an adverse effect on competition nor result in excessive market concentration. Therefore, in view of the objectives and considerations set forth in 10 CFR 784, all of which have been considered, it is recommended that the requested waiver, as set forth above, be granted.

[REDACTED]  
Mark P. Dvorscak  
Assistant Chief Counsel  
Intellectual Property Law Division

Date: June 28, 2005

Based on the foregoing Statement of Considerations and the representations in the attached waiver petition, it is determined that the United States and the general public will best be served by a waiver of rights of the scope described above, and therefore the waiver is granted. This waiver shall not apply to any modification or extension of this agreement, where through such modification or extension, the purpose, scope, or cost of the agreement is substantially altered.

CONCURRENCE: 11

[REDACTED]  
Michael J. McCabe  
Office of the Building Technologies  
Program, Energy Efficiency and  
Renewable Energy, EE-2J

Date: July 13 2005

APPROVAL: 1

[REDACTED]  
Paul A. Gottlieb  
Assistant General Counsel  
for Technology Transfer and  
Intellectual Property, GC-62

Date: JUL 13 2005

(t) U. S. COMPETITIVENESS The Contractor agrees that any products embodying any waived invention or produced through the use of any waived invention will be manufactured substantially in the United States unless the Contractor can show to the satisfaction of the DOE that it is not commercially feasible to do so. In the event the DOE agrees to foreign manufacture, there will be a requirement that the Government's support of the technology be recognized in some appropriate manner, e.g., recoupment of the Government's investment, etc. The Contractor agrees that it will not license, assign or otherwise transfer any waived invention to any entity unless that entity agrees to these same requirements. Should the Contractor or other such entity receiving rights in the invention undergo a change in ownership amounting to a controlling interest, then the waiver, assignment, license, or other transfer of rights in the waived invention is suspended until approved in writing by the DOE.

## ***WAIVER ACTION - ABSTRACT***

**W(A)-04-065 (CH-1243)**

### REQUESTOR

Cabot Superior  
MicroPowders, a  
division of Cabot  
Corporation Under  
DOE Cooperative  
Agreement No. DE-FC26-04NT42276

### CONTRACT SCOPE OF WORK

Development of Advanced LED  
Phosphors by Spray-Based Processes  
for Solid State Lighting Applications

### RATIONALE FOR DECISION

41.5% cost sharing

### DISPOSITION